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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,864	12/02/2003	Kathleen K. Martin	036762-0103	1602
22428 7590 06/22/2007 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER WOLLSCHLAGER, JEFFREY MICHAEL	
			ART UNIT 1732	PAPER NUMBER
			MAIL DATE 06/22/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/724,864	<b>Applicant(s)</b> MARTIN, KATHLEEN K.	
	<b>Examiner</b> Jeff Wollschlager	<b>Art Unit</b> 1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 51-64, 73 and 74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-64, 73 and 74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's amendment to the claims filed April 19, 2007 has been entered. Claim 51 is currently amended. Claims 1-50 and 65-72 have been canceled. Claims 51-64, 73 and 74 are pending and under examination.

### ***Specification***

The abstract of the disclosure is objected to because it appears to include a typographical error. The last sentence of the abstract recites "a device with a thicker pouch than panty". As found in paragraph [0033] of the instant specification, US 2005/011568, and the amended claims, the intended recitation appears to be "a device with a thicker panty portion than pouch". Clarification and correction, as needed, is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 51-63, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy (US 4,834,113) in view of Najor (US 5,638,829) and Morton (US 2,097,528) and either of Miller (US 5,284,157) or Shlenker (US 5,338,565).

Regarding claim 51, Reddy teaches a method of producing a prophylactic device comprising: providing a form for a casting including a portion configured to produce a panty and a portion configured to produce a pouch, wherein the panty includes a crotch portion and

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wherein the pouch is disposed on the crotch portion of the panty (Figure 12; col. 9, lines 38-49; Figure 18). Reddy generally discloses producing the prophylactic device by a conventional double dipping process, but does not provide details outlining the doubling dipping process (col. 13, lines 19-40). Reddy also teaches the thicknesses of the different portions may vary (col. 7, lines 6-25; col. 9, lines 8-25; col. 10, lines 37-42), but does not teach the pouch portion is thinner than the panty portion.

However, Najor discloses a similar prophylactic device as Reddy and teaches the tube/pouch should be as thin as possible to function as a sanitary barrier without sacrificing sensitivity and further exemplifies the belt/panty section of the article having a thickness of  $1/16$ " and the tube/pouch having a thickness of  $1/32$ " (col. 4, lines 11-41) thereby meeting the limitation that a thickness of the panty casting is larger than a thickness of the pouch casting. It is further noted that Najor teaches as a preferred embodiment that the cap/end (58) of the article is generally thicker than the tube/pouch or that the cap/end (58) has a larger diameter than the tube/pouch to promote anchoring of the device during use (col. 4, lines 27- 34).

Morton (page 1, col. 1, lines 1-col. 2, lines 45; page 2, col. 1, lines 17-63), teaches a dip molding process comprising dipping the former in a first concentrated/heavy coagulant (page 1, col. 1, lines 35-42) and then into a second diluted/light coagulant (page 2, col. 1, lines 30-40) to the depth required, then dipping the former comprising the different coagulant concentrations in to latex to secure the desired result of an article having thicker and thinner latex portions at locations on the produced article. Morton also generally teaches two or more dips into the latex may be employed (page 1, col. 2, lines 20-22).

Miller discloses that it is standard practice in the art to dip the condoms into the latex two times to insure no pinholes remain in the condom after the first dip (col. 4, lines 54-65) and Shlenker discloses a process for forming a rubber article comprising, after the first latex dipping

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step, a biocide dipping step followed by a second latex dipping step (Abstract; col. 1, lines 35-62; col. 2, lines 7-62).

Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to have employed the dip molding process disclosed by Morton for forming rubber articles with thicker and thinner portions as the dip molding process to form Reddy's prophylactic device comprising a panty and a pouch and to have practiced the method in such a manner as to form a pouch that is thinner than the panty as is taught by Najor and to have dipped the article a second time into the latex as is suggested by Shlenker or to just dip the condom/pouch portion of the article into the latex a second time as is suggested by Miller.

One having ordinary skill would have been motivated to combine Reddy with the secondary references for the purposes of practicing a simple, inexpensive and highly efficient dip molding process that offers fine thickness control of the article being produced (Morton: col. 1, lines 1-17), to ensure a sufficient sanitary barrier for the prophylactic device without sacrificing sensitive (Najor: col. 4, lines 20-41), and to reduce the spread of disease (Shlenker and Miller).

As to claims 52-55, Morton (see citations above) and Shlenker (col. 2, lines 28-62) disclose drying steps after the recited operative steps. Further, the prophylactic device is dry at the end of the process when it is removed from the form (Reddy: col. 9, lines 44-48). It is noted that as presented in the claims the sequence of the steps are only limited to being performed at some point after the recited step and that they could be performed after other steps have been performed. It is further noted that the coagulant and latex are intrinsically exposed to a drying step when they are removed from the dipping vat and that the claims do not specify complete or partial drying.

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As to claims 56 and 63, Shlenker et al., for example, disclose subjecting the form to a leaching process in a warm water rinse or bath (col. 2, lines 38-40).

As to claim 57, Reddy discloses curing the rubber (col. 9, lines 44-48).

As to claims 58 and 59, as set forth in the previous office action, applying powder on an exterior and interior portion of the casting is well known in the art for the purpose of facilitating removal of the completed rubber product from the mold and to facilitate donning of the completed product and would have been readily employed by the ordinarily skilled artisan at the time of the claimed invention.

As to claims 60 and 61, the latex and coagulants disclosed in the references are liquids (see citations above in the rejection of claim 51).

As to claim 62, the coagulants necessarily promote adherence of the latex.

As to claims 73 and 74, Morton discloses utilizing a heavy wall first coagulant and a light wall second coagulant (page 2, col. 1, lines 16-40).

Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy (US 4,834,113) in view of Najor (US 5,638,829) and Morton (US 2,097,528) and either of Miller (US 5,284,157) or Shlenker (US 5,338,565), as applied to claims 51-63, 73 and 74 above, and further in view of either of Shaller (U.S. 6,440,498) or Ambrose (U.S. 2,749,549).

As to claim 64, the combination as set forth above teaches the method of claim 51. Reddy does not teach the depressions as claimed. However, Gammeter (page 1, lines 14-19 and 74-84), Shaller (col. 10, lines 28-39), and Ambrose (col. 1, lines 64-71; col. 2, lines 17-26), analogously and individually teach a form including a plurality of depressions/grooves/recesses configured to form protrusions on the top/cuff/hip/body portion of the product.

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to have provided the form employed by Reddy with a plurality of depressions configured to the panty casting/top/hip/body portion in order to produce a product with raised protrusions, for the purpose as taught by Ambrose, of reinforcing the rubber article in the hip section (col. 1, lines 64-71; col. 2, lines 17-26).

### ***Response to Arguments***

Applicant's arguments filed April 19, 2007 have been fully considered, but are moot in view of the new grounds of rejection necessitated by the amendment to the claims. However, applicant's arguments regarding the Morton references are substantially addressed in the rejection set forth above. The examiner also notes that the claim language does not positively limit the second dipping of the form into the latex such that only the pouch portion is submerged.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 3,397,265 to Ansell discloses a method of making rubber articles containing thicker and thinner regions by application of heavy and light coagulants (col. 4, lines 18-68).

US 6,075,081 to Nile et al shows that employing powders on the inside and outside surface of a dipped product/form is conventional in the art (col. 1, lines 16-45).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Wollschlager whose telephone number is 571-272-8937. The examiner can normally be reached on Monday - Thursday 7:00 - 4:45, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JW

Jeff Wollschlager  
Examiner  
Art Unit 1732

June 15, 2007

  
CHRISTINA JOHNSON  
SUPERVISORY PATENT EXAMINER

6/16/07